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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/780,448	02/13/2004	Arturo A. Rodriguez	A-9740	1512

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SCIENTIFIC-ATLANTA, INC.  
INTELLECTUAL PROPERTY DEPARTMENT  
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EXAMINER

BELIVEAU, SCOTT E

ART UNIT PAPER NUMBER

2614

DATE MAILED: 10/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/780,448

Applicant(s)

RODRIGUEZ ET AL.

Examiner

Scott Beliveau

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 08 August 2005 has been entered.

### ***Priority***

2. Applicant's claim for domestic priority under 35 U.S.C. 119(e) is acknowledged. However, the provisional application (60/214,987) upon which priority is claimed fails to provide adequate support under 35 U.S.C. 112. In particular, the provisional application generally discloses that the user may select a video program and may further receive an on-screen notification that a particular title will no longer be available for rent (Page 8 – Notifications). However, with respect to claims 1 and 5, it is unclear from the provision application that this reminder information is actually provided "responsive to associating the selected video presentation with [a] reminder list" as opposed to the user simply viewing the available programs for rent.
3. With respect to applicant's claim for priority as a continuation-in-part to co-pending application No. 09/590,488, the earlier application discloses the overall system architecture of the utilized by the instant application (Figures 1-3) and illustrates similar GUI screen-

shots. The claimed subject matter of the independent claims of the instant application pertaining to the adding of a selected media title to a "reminder" list does not appear to be supported in the parent application. Accordingly, claims 1-8 of the instant application shall be examined in view of the filing date of the co-pending parent application (09/693,784) for which the instant application is a Divisional or 19 October 2000.

### ***Response to Arguments***

4. Applicant's arguments filed 08 August 2005 have been fully considered but they are not persuasive. The examiner respectfully disagrees that the LaJoie et al. reference fails to anticipate the newly amended claim and in particular that the reference fails to disclose and teach the feature of receiving viewer input that is configured to select a rentable video presentation for a reminder prior to any renting of the video presentation and providing reminder information to the viewer prior to an expiration date and prior to any renting of the video presentation. As defined in Webster's II: New College Dictionary, renting requires the granting of use of something (ex. property) in return for payment. The grounds previously set forth references the particular usage of the term "purchase". However, upon further review of LaJoie et al., purchases are not necessarily actual/active purchases (the act of renting) as opposed to being pending-purchase transaction wherein no exchange of funds or usage of the selected property (ex. movie) takes place unless the order is actually fulfilled and the event actually purchased.

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5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-8 are rejected under 35 U.S.C. 102(b) as being anticipated by LaJoie et al. (US Pat No. 5,850,218).

In consideration of claims 1 and 5, Figure 3 of LaJoie et al. illustrates a “television set-top terminal” [6] comprising “memory configured to store program code” [32] and a “processor programmed by the program code” [30] so as to implement a “method” for providing program reminder information. As illustrated in Figure 29, the method comprises “providing a list of rentable presentations” [576] and “receiving viewer input configured to select configured to select one of the titles from the list of rentable video presentations for a reminder” [594] (Figure 31) “prior to any renting of the title through the STT”. For example, after establishing a pending-purchase, the user can choose to view a summary of all pending events [596] (Figure 31) which serves as a reminder. Such can be provided, “prior to any renting of the title through the STT” as illustrated in Figure 30 whereupon the user can navigate from the summary screen [556] (to which the user is returned upon a time-out wherein the PPV event is still pending). Subsequently, upon pressing the CH up/down button, as illustrated in Figure 30, the system may inform the user that the event was not actually purchased/rented and the system presents and “receives information corresponding to an expiration date for the rentability of the rentable video presentation after which date the video presentation will be removed from the list of rentable video presentations and is no

longer available to be rented” [544] should the presentation not be purchased/rented or the problem with the actual renting not be resolved.

In light of the aforementioned, the reference meets the limitation of “responsive to associating the selected rentable video presentation with the reminder list and receiving information corresponding to the expiration date for the rentability of the rentable video presentation, providing reminder information to the viewer prior to the expiration date and prior to any renting of the title through the STT” [544] such that the “reminder information [is] configured to remind the viewer of the expiration date” (ex. Today at 8:15) for “the rentability of the rentable video presentation while the selected rentable video presentation remains available for rent via the STT”.

Claims 2 and 6 are rejected wherein the “step of providing reminder information is performed responsive to viewer input requesting access to the reminder list” (Figure 31).

Claims 3 and 7 are rejected wherein the “step of providing reminder information is performed responsive to viewer input requesting access to a list of presentations currently available for rent” such that the reminder information pertaining to the time frame in which the program is ordered is presented subsequent to the user ordering the presentation from a list of presentations currently available for rent as required by the first portion of claim 1.

Claims 4 and 8 are rejected wherein the “step of providing reminder information is performed via a barker” [544].

### ***Conclusion***

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The prior art made of record and not relied upon is considered pertinent to applicant's disclosure as follows. Applicant is reminded that in amending in response to a rejection of claims, the patentable novelty must be clearly shown in view of the state of the art disclosed by the references cited and the objections made.

- The Goode et al. (WO 00/59202 A2) reference discloses the distribution of meta-data which defines the expiration dates for available content.
- The Leftwich (US Pub No. 2005/0138657) reference provides evidence that it is known to receive information corresponding to an expiration date for a video presentation.
- The Schlarb et al. (WO 99/57903 A1) reference discloses a method and apparatus for the processing of PPV events.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott Beliveau whose telephone number is 571-272-7343.

The examiner can normally be reached on Monday-Friday from 8:30 a.m. - 6:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller can be reached on 571-272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Scott Beliveau  
Examiner  
Art Unit 2614

SEB  
October 7, 2005